

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Thomas H. Slaight et al.  
U.S. Patent Serial No.: 09/737,697  
Filing Date: December 14, 2000  
Art Unit: 3691  
Examiner: Olabode Akintola  
Confirmation No.: 1400  
Title: Sourcing System and Method

**Mail Stop: AF**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicants respectfully request reconsideration of the application in light of the remarks set forth below.

**REMARKS**

Applicants contend that the rejections of Claims 2-10 and 12-32 on prior art grounds contain clear legal and factual deficiencies, as described below. In a Final Office Action mailed January 26, 2009 (the "Final Office Action"), Claims 2-3, 5-7, 10, 12, 14-18, 20-22, and 23-32 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 7,249,085 issued to Kinney, Jr. et al. ("*Kinney*"). Claims 4, 8, and 13, were rejected under 35 U.S.C. § 103(a) as unpatentable over *Kinney* in view of U.S. Patent No. 5,835,896 issued to Fisher et al. ("*Fisher*"). Claim 9 was rejected under 35 U.S.C. § 103(a) as unpatentable over *Kinney* in view of U.S. Patent No. 5,402,336 issued to Spiegelhoff et al. Claim 23 was rejected under 35 U.S.C. § 103(a) as unpatentable over *Kinney* in view of U.S. Patent No. 7,107,268 issued to Zawadzki et al. Applicants request a finding that these rejections are improper and allowance of all pending claims.

With respect to Independent Claim 5, the Final Office Action contends *Kinney* discloses "means for enabling the purchaser to make at least one adjustment corresponding to at least one of the vendor bids which is used by the calculating means to determine the total cost of the product to the purchaser." See Final Office Action, p. 3. The Final Office Action, however, is incorrect. The portions of *Kinney* cited by the Examiner merely state:

This confidential information gives the buyer leverage in altering the supplier's perception of the relative attractiveness of the submitted bid. During the negotiation process, suppliers may be selectively informed (at their disadvantage) of aspects of the decision making process.

*Kinney* at Col. 7, Lines 32-34.

Accordingly, the buyer desires to prevent the suppliers from gaining insight into aspects of the transformation function that quantifies the buyer's weighting of various parameters associated with a supplier's bid. For this reason, the auction server does not feedback the transformed bids to the participating suppliers.

*Kinney* at Col. 9, Lines 30-34.

These two sections merely disclose that a buyer may selectively transmit information to a supplier-bidder regarding the transformation function used by the buyer in the decision making process. However, merely selecting which aspect of the decision-making process to transmit to the a supplier-bidder fails to teach, suggest, or disclose "means for enabling the purchaser to make at least one **adjustment**

corresponding to at least one of the vendor bids,” much less using this means “to determine the total cost of the product to the purchaser.” Indeed, *Kinney* fails to disclose that the selectively withheld or transmitted information has any impact whatsoever on the total cost of a product to the buyer.

The Final Office Action attempts to cure this deficiency by stating that “the buyer can alter the supplier’s perception of the relative attractiveness of the submitted bid.” Final Office Action, p. 8. However, altering the attractiveness of a bid from a supplier’s perspective still fails to teach, suggest, or disclose “means for enabling the purchaser to make at least one adjustment corresponding to at least one of the vendor bids,” or using this means “to determine the total cost of the product to the purchaser.”

The Final Office Action also argues that “the buyer [in *Kinney*] inherently modifies or adjusts the supplier’s bid using the transformation function.” Final Office Action, p. 8. However, *Kinney* does not provide any such “inherent” disclosure. Indeed, the only basis the Examiner provides for this erroneous characterization are that “the factors used in the transformation function [are] confidential to the buyer,” and that “the transformation function [is] subjectively determined by the buyer.” Final Office Action, p. 8. *Kinney* does not disclose the transformation function is “subjectively determined” by the buyer nor does the Examiner provide any citation for this contention. Furthermore, the Examiner’s interpretation of the confidentiality or subjectivity of the transformation function fails to disclose “means for enabling the purchaser to make at least one adjustment corresponding to at least one of the vendor bids which is used by the calculating means to determine the total cost of the product to the purchaser.” For at least these reasons, the rejection of Claim 5 is improper. Therefore, Applicants request that the rejection of Claim 5 be withdrawn.

Similar to Claim 5, Claim 15 recites “software stored on a computer readable storage medium and operable, when executed to . . . enable the purchaser to make at least one adjustment corresponding to at least one vendor bid . . . to calculate the total cost of the product to the purchaser.” Likewise, Claim 25 recites a method comprising “enabling the purchaser to make at least one adjustment corresponding to at least one vendor bid which is used by the computer to calculate the total cost of the product to the purchaser.” Therefore, Applicants submit that Claims 15 and 25 are allowable, for example, for reasons similar to those discussed above with regard to

Claim 5. As such, Applicants request that the rejections of Claims 15 and 25 be withdrawn.

Claims 2-4 and 6-10, Claims 12-14 and 16-24, and Claims 26-32 depend from Claims 5, 15, and 25, respectively. Therefore Applicants submit that Claims 2-4, 6-10, 12-14, 16-24, and 26-32 are allowable, for example, for reasons similar to those discussed above with regard to Claims 5, 15, and 25. As such, Applicants request that the rejections of Claims 2-4, 6-10, 12-14, 16-24, and 26-32 be withdrawn.

Dependent Claims 4 and 13 are also allowable to an additional reason. With regard to Claim 4, the Final Office Action contends that the *Kinney-Fisher* combination suggested by the Examiner teaches, suggests, for discloses “means for communicating a vendor bid having the best total cost for the product to the vendors **without revealing the identification of the vendor with the best total cost.**” See Final Office Action, p. 6. However, the Final Office Action is again incorrect.

The Final Office Action relies upon *Fisher* as disclosing this limitation. However, *Fisher* actually teaches away from the above feature. For example, the bidders in *Fisher* are not the claimed **vendors** but rather are potential **purchasers** who are competing for items on a merchandise catalogue page by submitting ever-increasing bids. The Final Office Action attempts to cure this deficiency by stating, “the bidders in *Fisher* are broadly interpreted as either purchasers (forward auction format) or vendors (reverse auction format).” Final Office Action, p 8. However, the terms “forward auction format” or “reverse auction format” do not appear in *Fisher*. Indeed, the Examiner bases this mischaracterization of *Fisher* entirely on the phrase “a variety of formats” appearing in the Abstract. The particular “variety of formats” disclosed in *Fisher*, however, fail to disclose variations where the bidders are potential **vendors** and instead disclose only formats where the bidders are **purchasers**. See, e.g., *Fisher*, col. 10, l. 6 - col. 11, l. 64 (disclosing the Standard Auction format, the Dutch Auction format, the Progressive Auction format, and the Buy or Bid format). For at least this additional reason Claim 4 is allowable.

Similar to Claim 4, Claim 13 recites “software . . . operable to send data, comprising a vendor bid having the best total cost for the product, to the vendors during the auction without revealing the identification of the vendor with the best total cost.” Therefore, Applicants submit that Claim 13 is allowable, for example, for reasons similar to those discussed above with regard to Claim 4.

**CONCLUSION**

As the rejections of Claims 2-10 and 12-32 contain clear legal and factual deficiencies, Applicants respectfully request full allowance of Claims 2-10 and 12-32. To the extent necessary, the Commissioner is hereby authorized to charge any required fees or credit any overpayments to **Deposit Account No. 19-2179** of Baker Botts L.L.P.

Respectfully submitted,

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